

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#15  
8/6/02  
T-10

In application of

DONALD R. RUSSELL and  
JOSEPH J. KALWARA  
Serial No. 09/505,052

Filed February 16, 2000

) Group Art Unit 3635

) Y. Horton, Examiner

) CERTIFICATE OF MAILING

) I hereby certify that this correspondence was deposited  
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) for Patents, Washington, D.C. 20231  
) on this 22nd day of July, 2002

*Mary Spoonster*  
Mary Spoonster, Secy. to Arthur M. Reginelli

For: SELF-ADHERING WALKWAY PADS  
FOR ROOFING MEMBRANES AND  
METHOD FOR THE APPLICATION  
THEREOF TO ROOFS

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**GROUP 3600**

**APPELLANTS' BRIEF PURSUANT TO 37 C.F.R. 1.192**

BOX AF  
ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

Dear Sir:

This is an appeal to the Board of Patent Appeals from the final rejections in the Office Action mailed November 27, 2001. The Notice of Appeal was mailed on April 22, 2002. The present appeal is of claims 1-4, 6-24 and 27. This Appeal Brief is submitted in triplicate.

**I. REAL PARTY IN INTEREST**

The owner of the present patent application is Bridgestone Firestone Diversified Products LLC.

**II. RELATED APPEALS AND INTERFERENCES**

Appellant and Appellant's legal representatives are not aware of any related appeals or interferences that would directly affect or would be directly affected by, or have a bearing on the Board's decision in the present pending appeal.

### **III. STATUS OF CLAIMS**

The present application was filed on February 16, 2000 as a divisional of U.S. Patent Application Serial No. 09/039,849 filed on March 16, 1998, now U.S. Patent No. 6,080,458, which is a continuation of U.S. Patent Application Serial No. 08/606,119, filed on February 23, 1996, now abandoned. At the time of filing, the divisional application included claims 1-7. Claims 1-7 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,504,136 to Davis et al. in an Office Action dated March 14, 2001. In a Response and Amendment filed June 14, 2001, colorable amendments were made to claims 1-4 and 6-7, and claim 5 was cancelled,<sup>1</sup> and claims 8-27 were added. In view of this Response and Amendment, the Examiner issued a final rejection on November 27, 2001, wherein the Examiner rejected claims 1-4, 6-24, and claim 27, and withdrew from consideration claims 25 and 26.<sup>2</sup> A Response and Amendment After Final was filed on January 28, 2002, wherein Appellant cancelled claims 25 and 26, added recitation to claims 8 and 27, and made colorable changes to claims, 1, 14, and 15. An Advisory Action was issued on March 20, 2002, wherein the Examiner maintained the previous rejections but indicated that the amendments were entered.

### **IV. STATUS OF AMENDMENTS**

As noted above, the Examiner indicated that the amendments in the Response and Amendments After Final were entered, and therefore the status of the claims on appeal are as they stood with the Examiner at the time of that response and amendment.

### **V. SUMMARY OF THE INVENTION**

The claimed invention generally relates to the manufacture and installation of walkway pads that include a factory-applied adhesive.

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<sup>1</sup> Despite the fact that Appellants cancelled claim 5, the Examiner has indicated in both the Final Rejection and Advisory Action that claims 1-24 and 27 are pending. The Examiner is in error.

<sup>2</sup> Accordingly, the rejections on Appeal were first presented in a Final Office Action. Appellants filed a Petition contesting the issuance of a Final Rejection, but this Petition was denied. Appellants maintain that the Amendments made in the first Response and Amendment did not warrant a new grounds for rejection. Indeed, the present rejections, although in error, could have been made of the original claims.

Walkway pads are known. Conventionally, walkway pads are used to protect the high-traffic areas of roofing membranes. As those skilled in the art appreciate, roofing membranes (e.g. EPDM membranes) are commonly employed to cover and waterproof flat or low-slope roofs. These synthetic membranes are typically employed in lieu of tar or asphalt materials. Because these membranes are subject to damage by traffic (e.g. walking on the roof) or servicing roof-mounted equipment (e.g. service personnel working on fans or condensers), it is important to protect the membrane. Walkway pads are used to protect the roofing membrane from a variety of potential damage and puncture sources.

In most situations, the walkway pads are affixed to the roofing membrane so that high-traffic or service areas can be protected from damage. It is therefore important to securely affix the walkway pad to the roof membrane so that the walkway pads will not be uplifted by environmental conditions (e.g. wind), which could scatter them across the roof or off of the roof.

Conventionally, walkway pads are affixed to the roof membrane by using an adhesive tape. The area of the membrane to receive the walkway pad is typically primed, and the adhesive tape is applied to the primed area. The walkway pad is then preferably primed and secured to the membrane by applying the walkway pad to the exposed tape.

This procedure, however, is labor intensive. And, this procedure requires that service personnel ensure that the area of the walkway pad that contacts the adhesive is cleaned and primed. Where service personnel fail to adequately clean and prime the walkway pad, adhesion to the roof membrane may be compromised and fail.

Appellants have solved the problems in the prior art by manufacturing a walkway pad that includes a factory-applied adhesive. By applying the adhesive to the walkway pad prior to use in the field, especially under controlled factory conditions, the probability of securely adhering the tape to the walkway pad is greatly increased. And, because service personnel no longer are required to clean and prime the walkway pad in order to secure it

to the roof, and because they are no longer required to apply an adhesive tape to the roof membrane, installation time is expedited.

## **VI. ISSUES**

The issue of the present appeal is whether:

(i.) Claims 1-2, 8-10 and 24 are anticipated by U.S. Patent 3,903,340 to Shepard;

(ii.) Claim 27 is anticipated by U.S. Patent 3,903,340 to Shepard;

(iii.) Claims 6-7 and 13-15 are obvious over U.S. Patent 3,903,340 to Shepard;

(iv.) Claims 3 and 11 are obvious over U.S. Patent 3,903,340 to Shepard in view of U.S. Patent 4,855,172 to Chiu or the commercially available products of Adco Products, Inc. or Ashland Chemical;

(v.) Claims 4 and 12 are obvious over U.S. Patent 3,903,340 to Shepard;

(vi.) Claims 16-17 and 20-23 are obvious over U.S. Patent 3,903,340 to Shepard;

(vii.) Claim 19 is obvious over U.S. Patent 3,903,340 to Shepard in view of U.S. Patent 4,855,172 to Chiu or the commercially available products of Adco Products, Inc. or Ashland Chemical;

(viii.) Claim 19 is obvious over U.S. Patent 3,903,340 to Shepard in view of U.S. Patent 4,855,172 to Chiu or the commercially available products of Adco Products, Inc. or Ashland Chemical; and

(ix.) Claims 6, 7, and 13 are indefinite.<sup>3</sup>

## **VII. GROUPING OF CLAIMS**

With respect to grouping of the claims:

Claim 1 is an independent claim directed to a method for applying a walkway pad to a roofing membrane. Claims 2-4 and 6-7 ultimately depend from claim 1, but, for purposes of this appeal, claims 6 and 7 are believed to be

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<sup>3</sup> Appellants believe that the indefinite rejections levied by the Examiner in the Final Office Action were adequately addressed by Amendment in the Response After Final. The Examiner, however, gave no indication in the Advisory Action that the Amendments overcame the rejection.

separately patentable in view of the rejections. Claims 2-4 stand or fall with claim 1 in view of the present rejections.

Claim 8 is an independent claim that is directed toward a method for applying a walkway pad to a roofing membrane, and claims 9-15 and 24 ultimately depend from claim 8. In view of the issues on appeal, claims 9, 13, 14, 15, and 24, are separately patentable. Claims 10-12 stand or fall with independent claim 8 in view of the rejections on appeal.

Claim 16 is an independent claim that is directed toward a method for providing a walkway pad to service personnel, and Claims 17-23 depend from claim 16. Claims 20- 22 are separately patentable, but claims 17-19 and 23 stand or fall with independent claim 16 in view of the rejections on appeal.

Claim 27 is an independent claim directed toward a method of making a walkway pad.

Each of the independent claims are separately patentable and therefore do not stand or fall together.

## **VIII. ARGUMENT**

Each of the Examiner's rejections, whether grounded on 35 U.S.C. 102 or 103, relies on U.S. Pat. No. 3,903,304 to Shepard. Shepard solely and exclusively discloses improvements to roofing shingles to address packaging problems. The errors in the Examiner's conclusions are apparently a result of not understanding the construction, manufacture, packaging and installation of roofing shingles.<sup>4</sup> With an understanding of the design construction, manufacture, packaging and installation of roofing shingles, the patentability of the subject invention will become apparent.

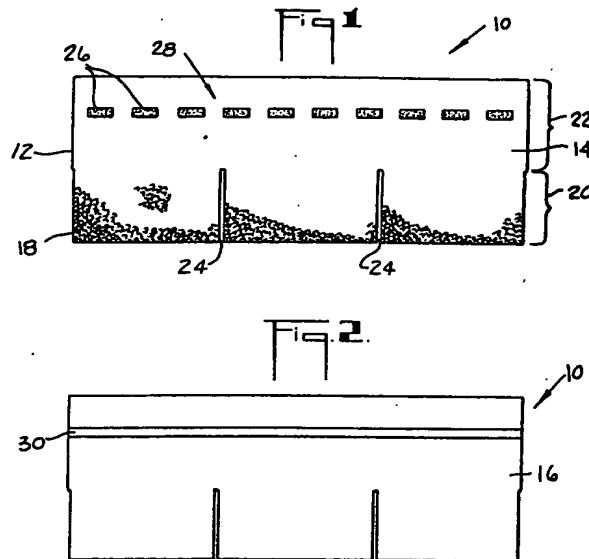
As those skilled in the art appreciate, a roofing shingle is an asphaltic product that is applied in overlapping layers on a roof. Shepard teaches that a shingle includes a body having two distinct planar surfaces and tabs:

"... a typically somewhat rectangular body 12 including a top surface 14 (FIG. 1) and a back surface 16 (FIG. 2). . . body 12 can be separated into two segments, a forward most butt segment 20 and a rearward most head segment

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<sup>1</sup> U.S. Patent No. 3,903,340 at Col. 1, lines 5-10

22 . . . [b]utt segment 20 may be a plurality of tabs, as illustrated in FIGS. 1 and 2 . . . ”<sup>5</sup>



More specifically, the shingles of Shepard are self-sealing shingles that include an adhesive on their top surface. This adhesive adheres to and prevents the tabs of overlapping shingles from being uplifted by wind:

“[t]oday, the self-sealing roof shingle is of commercial significance in the roofing industry. As is well know, this type of shingle includes a resin adhesive self-sealing stripe in a predetermined location on one surface, i.e., usually the top surface of the single. Hence, when shingles of this type are applied to a roof in typical overlapping relationship, the adhesive stripe on one shingle adheres to the surface of an adjacent shingle, especially in response to heated ambient surroundings and/or pressure, causing the shingles to seal together.”<sup>6</sup>

The advancement in the art offered by Shepard is a solution to the problem of the self-sealing adhesive adhering to other shingles while the shingles are shipped or stored within a bundle:

“[a] serious problem can result form shipping the self-sealing shingles in the aforescribed bundles. Specifically, the self-sealing adhesive of one shingle tends to stick to the surface of an adjacent shingle. If the roofer goes to

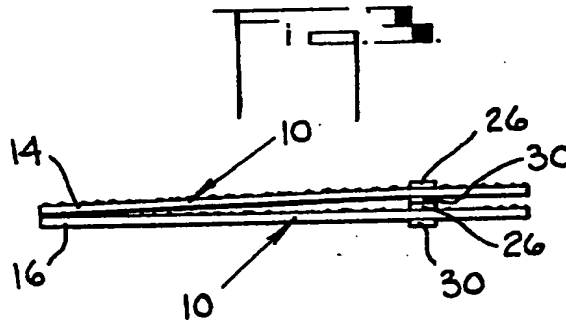
<sup>5</sup> *Id.* At Col. 2, lines 55-68

<sup>6</sup> *Id.* At Col. 2, lines 12-22

separate the shingles, some or all of the adhesive may be pulled off its associated shingle or shingles may be inadvertently damaged in this process.”<sup>7</sup>

Shepard solves this problem by applying a separating membrane (stripe) on the bottom surface of the shingles. As a result, the adhesives applied to the top surface of one shingle contacts the separating stripe applied to the bottom surface of an adjacent shingle within a bundle:

“[a]s indicated in FIG. 3, the separating stripe 30 located on the bottom surface of the top shingle completely covers and is in contact with the self-sealing stripe 28 on the top surface of the lower shingle. In this manner, the self-sealing stripe is prevented from sticking to other portions of the adjacent shingle and possibly being damaged or causing damage to either of the shingles during separation of the two.”<sup>8</sup>

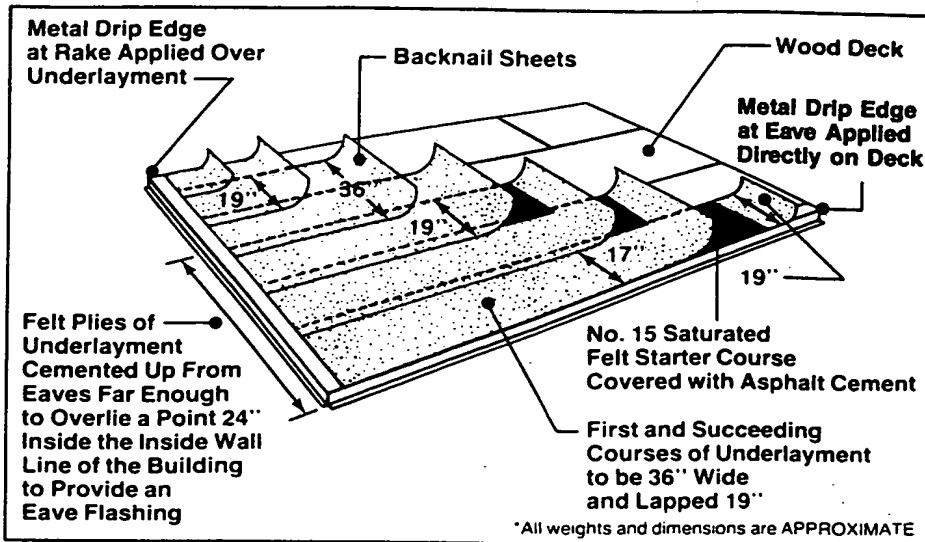


It also appears that the Examiner fails to appreciate how shingles are applied to a roof deck. Conventionally, an underlayment is applied and nailed to a roof deck.<sup>9</sup>

<sup>7</sup> *Id.* At Col. 1, lines 29-36

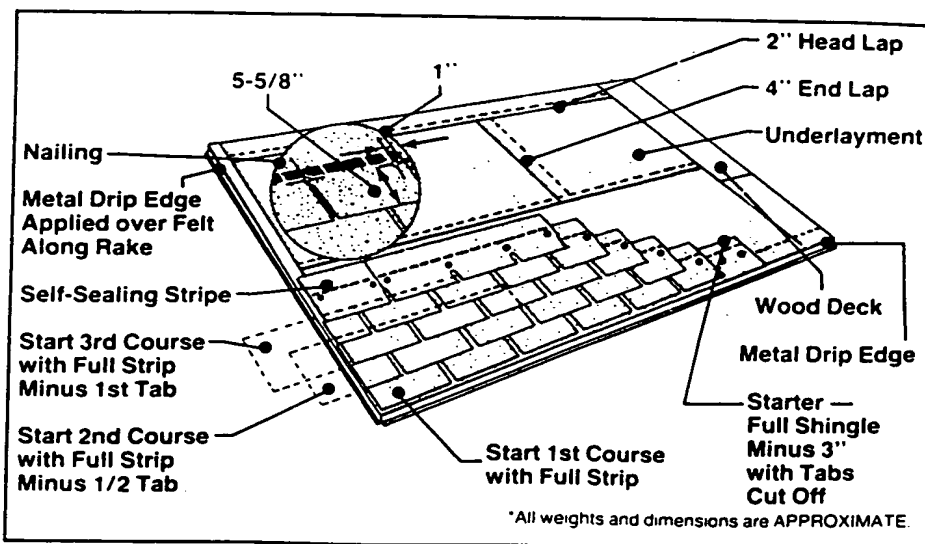
<sup>8</sup> *Id.* At Col. 4, lines 18-25

<sup>9</sup> The National Roofing Contractor Association Roofing and Waterproofing Manual; Asphalt Roofing (Appendix B)



**FIGURE 1**  
Application of Double Layer Felt Underlayment and Eave Flashing

The shingles are then applied over the underlayment. Specifically, the shingles are aligned to partially overlap the lower-adjacent shingle (except for the lowermost row), and each shingle is secured to the roof deck by using nails or staples.<sup>10</sup>



**FIGURE 15**  
Three-Tab, Square-Butt Strips—Cutouts are Centered Over the Tabs in the Course Below

<sup>10</sup> *Id.*



As shown in the foregoing figure, the sealing stripe or adhesive stripe taught by Shepard does not contact the underlayment. In other words, the sealing stripe **does not** secure the shingle to the roof – the nails do! The sealing strip is on the top side of the shingle and thereby the tabs of overlapping shingles are secured from wind uplift by the sealing stripe.

In view of the foregoing, the patentability of the subject claims is readily apparent.

With respect to the rejections under 35 U.S.C. 102, it should go without saying that to anticipate a claim, the prior art reference must teach every element of the claim, i.e., every step of Applicant's process must be taught by Shepard.<sup>11</sup> And, patentability can likewise be established for a process that employs non-obvious starting materials to achieve a non-obvious end product.<sup>12</sup>

Claim 1 recites affixing a solids tape to a walkway pad at the location where the pad is manufactured. The tape carries a release paper that is removed prior to use or application. Application of the walkway pad occurs by subsequently placing the exposed surface of the tape directly onto the upper surface of the roofing membrane.

Although several distinctions exist between claim 1 and the teachings of Shepard, there should be no question that Shepard does not teach "placing the exposed surface of said tape directly onto the upper surface of the roofing membrane." As discussed above, Shepard applies an adhesive to the top surface of the shingle, and that adhesive is not contacted to the roof. Instead, the shingle is secured to the roof by nails or staples, and the adhesive remains exposed so that it can receive or secure the tab of an upper-adjacent shingle. The method of claim 1 employs the adhesive to secure the walkway pad to the roof.

Furthermore, the adhesive of Shepard does not carry a release paper. As discussed above, the separating stripe of Shepard (which the Examiner apparently believes is analogous to a release paper) is applied to the opposite side of the shingle, i.e., the side opposite the adhesive.

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<sup>11</sup> *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81 (Fed. Cir. 1986)

<sup>12</sup> *In re Ochiai*, 37 U.S.P.Q. 1127 (Fed. Cir. 1995)

Claim 8 likewise recites a walkway pad that includes a solids tape applied thereto. And, the walkway is applied to the roofing membrane “by placing an exposed surface of the solids tape directly onto the upper surface of the roofing membrane.” Shepard does not teach a walkway pad having a tape applied thereto and does teaching “applying . . . by placing . . . solids tape directly onto . . . the roofing membrane.”

Claim 9, which is dependent on Claim 8, is distinct from Shepard because the adhesive of Shepard is not proximal to opposed edges of the flat surface of the walkway pad. The adhesive is placed in the center of the shingle so that it can contact or receive the tabs of the upper-adjacent shingle. See Fig. 1 of Shepard.

Claim 24, which is dependent on Claim 8, recites that the tape carries a release paper. The adhesive of Shepard does not carry a release paper.

Claim 27 recites a method of making a walkway pad including applying a release paper directly to a solids tape. The shingle of Shepard does not include an adhesive that carries a release paper. Accordingly, Shepard can not teach the method of Claim 27 – inherently or otherwise.

With respect to the rejections under 35 U.S.C. 103, the Examiner must provide some teaching that suggests or would motivate one skilled in the art to modify a prior art teaching or to combine prior art teachings.<sup>13</sup> The Examiner must also establish that those skilled in the art would have some expectation of success when modifying or combining the prior art. In either event, the modification or combination must amount to or arrive at the claimed invention.<sup>14</sup> Finally, the modification or combination can not be performed with benefit of hindsight.<sup>15</sup>

Independent Claim 16 recites a method for providing walkway pads including preparing a self-adhering walkway pad by affixing a solids tape that carries a release paper. The Examiner acknowledges that Shepard is silent with respect to the delivery step, but nonetheless believes that it would have obvious to stack the shingles and deliver them for use.

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<sup>13</sup> *In re Dow Chemical*, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988)

<sup>14</sup> *Id.*

<sup>15</sup> *Id.*

Independent Claim 16 is patentable over Shepard without reliance to the Examiner's hindsight modification. That is, even if the Examiner's position is correct with respect to the delivery step, the Examiner's assumptions fall short of the claimed invention because Shepard does not teach a walkway pad including a tape that carries a release paper. And, there is no motivation or suggestion to alter the teaching of Shepard to do so. Instead, Shepard teaches against this modification in that the separating stripe of Shepard is on the opposite side of the shingle.

Claim 20, which depends from Claim 16, recites that the tape is affixed proximal to opposed edges of the walkway pad. The adhesive is placed in the center of the shingle so that it can contact or receive the tabs of the upper-adjacent shingle. See Fig. 1 of Shepard.

Dependent Claims 6 and 13 recite the step of preparing the roofing membrane to which the walkway pad will be applied, and dependent claim 7 recites that the step of preparing includes the step of priming the area of the membrane to which the pad will be applied. Shepard not only fails to teach any step of preparing or priming the membrane to which the shingles will be attached, to do so would be illogical. Namely, the shingles of Shepard are attached to the roof via nails or staples. Therefore, one skilled in the art would not be inclined to prepare or prime the roof membrane (e.g. underlayment) prior to application of the shingles. The step of preparing or priming is a direct consequence of using an adhesive to adhere the walkway to the roofing membrane. The shingles are applied with nails or staples!

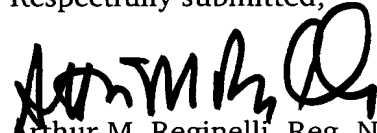
Finally, the Appellants believe that the Amendments made in the Response After Final were sufficient to overcome all rejections under §112. Because Appellants believe that the Examiner's failure to remove these rejections from issue was an oversight on the part of the Examiner, Appellants have no further amendments to make at this time, and seek reconsideration of the Amendments that have been made in view of the §112 rejections.

## IX. CONCLUSION

Appellant maintains that the Examiner has erred in concluding that the claims on appeal are anticipated or obvious over the cited prior art. The Examiner's reliance on Shepard is misdirected because Shepard fails to teach steps recited in the claims, and Shepard fails to teach or suggest the walkway defined in the claims. The shingles taught by Shepard are not only distinct from the walkway pads defined in the claims, but the structural distinctions between shingles and walkway pad dictate that their manufacture and installation must be different. Accordingly, Shepard does not anticipate the claimed invention and does not provide sufficient teaching to render the claimed invention obvious, either alone or in combination with the other prior art of record

Per the accompanying Transmittal Sheet, The Commissioner is authorized to charge Deposit Account No. 06-0925 for \$320.00, which is the amount due for the filing of this brief.

Respectfully submitted,



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Attorney for Applicants

July 22, 2002



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) Mary Spoonster, Secy. to Arthur M. Reginelli

**TRANSMITTAL SHEET**

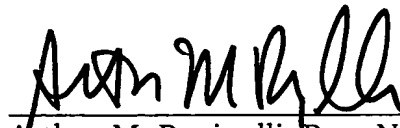
Enclosed are the following documents:

Appeal Brief (in triplicate) (w/attached Certificate of Mailing)  
Appendix A and B (in triplicate)  
Request for Extension of Time  
Transmittal Sheet  
Return Receipt Postcard

**AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

The Commissioner is hereby authorized to charge payment of the Appeal Brief in the amount of \$320.00 (Large Entity), the Extension of Time, in the amount of \$110.00, and any additional fees associated with this communication to Deposit Account No. 06-0925.

Respectfully submitted,



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